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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/534,922	01/30/2006	Philip John Hogg	05-363	1798
20306 7590 01/23/2009 MCDONNELL BOEHNEN HULBERT & BERGHOFF LLP 300 S. WACKER DRIVE 32ND FLOOR CHICAGO, IL 60606				
EXAMINER				
STONE, CHRISTOPHER R				
ART UNIT		PAPER NUMBER		
1614				
MAIL DATE		DELIVERY MODE		
01/23/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/534,922

Applicant(s)

HOGG, PHILIP JOHN

Examiner

CHRISTOPHER R. STONE

Art Unit

1614

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 October 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) 6-8, 20-22 and 24-26 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 9-19, 23, 27 and 28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

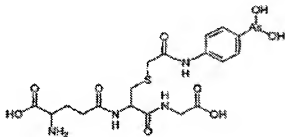
- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Applicants' arguments, filed October 28, 2008, have been fully considered but they are not deemed to be persuasive. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn. The following rejections and/or objections are either reiterated or newly applied. They constitute the complete set presently being applied to the instant application.

Status of Claims

Claims 1-28 are pending. Claims 6-8, 20-22 and 24-26 are withdrawn from consideration as being drawn to nonelected inventions/species. Claims 1-5, 9-19, 23, 27 and 28 are currently under examination. The compound below is the elected species currently under examination.



Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4, 9-19, 23, 27 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Constantini et al (Oncogene, 2000, Vol. 19, p. 307-314, provided by Applicant) in view of Hogg et al (WO 01/21628), further in view of Sawada et al (US Patent 5270196).

Claims 1-3, 9-19, 23, 27 and 28 are drawn to a method for identifying the elected compound which selectively induces mitochondrial permeability transition (MPT) in proliferating cells comprising contacting a cell or cell extract with the elected compound, determining whether the compound binds to the adenine nucleotide translocator (ANT) and determining whether the compound selectively induces the MPT in proliferating cells, relative to non-proliferating cells.

Constantini et al teaches that agents that are able to bind ANT induce MPT, which then causes apoptosis (abstract and p. 311, right column, first paragraph). Said agents are additionally taught to be useful as cytotoxic agents in the treatment of cancer (p. 312, left column, first paragraph). Constantini et al further teaches that MPT is associated with cellular release of cytochrome C (p. 307, left column, last paragraph to right column, first paragraph) Constantini et al does not teach the elected compound or the method further comprising determining whether the compound selectively induces the MPT in proliferating cells, relative to non-proliferating cells.

Hogg et al teaches that the elected compound is useful in the treatment of proliferative diseases, including cancer (compound of formula IV, where $-As=O$ is replaced by the arsenoxide equivalent, $-As(OH)_2$, p. 10, lines 18 and 19, p. 12, lines 8-10, p. 13, lines 29 and 30, claims 40-42).

Sawada et al teaches that a major problem with cancer chemotherapy is the nonspecific action of anti-tumor agents, which causes damage to normal (growth quiescent cells) and agents which selectively act on tumor cells are desirable (column 1, lines 19-24).

Therefore it would have been obvious to one of ordinary skill in the art at the time of the instantly claimed invention to practice the instantly claimed method to identify the known cytotoxic elected compound which selectively induces mitochondrial permeability transition (MPT) in proliferating cells comprising contacting a cell or cell extract with the known elected compound, determining whether the compound binds to the adenine nucleotide translocator (ANT) and determining whether the compound selectively induces the MPT in proliferating cells, relative to non-proliferating cells, since it was known that binding to ANT is indicative of stimulating MPT and MPT causes apoptosis and this activity was known to be useful for the treatment of cancer. Determining whether this activity is present only in proliferating cells (i.e. cancer cells) would have obvious to one of ordinary skill in the art because of the known complication of non-specific chemotherapy agents causing damage to normal (growth quiescent) cells. Additionally it would have been obvious to one of ordinary skill in the art at the time of the instantly claimed invention to measure the induction of MPT by measure cytochrome C release, since it was known that MPT is associated with cellular release of cytochrome C, thus resulting in the practice of the instantly claimed invention with a reasonable expectation of success.

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Constantini et al (Oncogene, 2000, Vol. 19, p. 307-314, provided by Applicant) in view of Hogg et al (WO 01/21628), Sawada et al (US Patent 5270196) and Cai et al.

Constantini et al, Hogg et al and Sawada et al teach the aforementioned method, but do not the method comprising determining the induction of MPT by measuring cellular superoxide concentration. Cai et al teaches that an increase in cellular superoxide is associated with MPT (abstract). Therefore it would have been obvious to one of ordinary skill in the art at the time of the instantly claimed invention to determining the induction of MPT by measuring cellular superoxide concentration, since determining MPT was known to be useful in the above method, and increased cellular superoxide was known to be associated with MPT.

Response to Arguments

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the examiner has clearly stated the reasoning for combining said references. It was known that binding to ANT is indicative of stimulating MPT and MPT causes apoptosis and this activity was known to be useful for the treatment of cancer. Determining whether this activity is

present only in proliferating cells (i.e. the compound is selective for cancer cells) would have obvious to one of ordinary skill in the art because of the known complication of non-specific chemotherapy agents causing damage to normal (growth quiescent) cells. Furthermore, one of ordinary skill in the art would have recognized the elected species of Hogg et al as an appropriate compound for screening since the compound was known to be useful in the treatment of proliferative disease. Applicant further argues that one of ordinary skill in the art would not have a reasonable expectation of success in identifying compounds that selectively induce the MPT in proliferating cells. This is not found persuasive because the instant claim method, as defined by its active steps, requires only contacting a cell with a compound and determining whether it binds ANT and induces MPT, i.e. the claim does not require that a compound induce MPT in proliferating cell and not non-proliferating cells. One of ordinary skill in the art could carry out this method with the elected specie of compound for the reasons noted above.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHRISTOPHER R. STONE whose telephone number is (571)270-3494. The examiner can normally be reached on Monday-Thursday, 7:30am-4:00pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ardin H. Marschel can be reached on (571) 272-0718. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

15January2009
CRS

/Patricia A. Duffy/
Primary Examiner, Art Unit 1645

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